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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/807,459

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Eric Benazzi

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EXAMINER

HAILEY, PATRICIA L

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/807,459	Applicant(s) BENAZZI ET AL.	
	Examiner PATRICIA L. HAILEY	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008 and 12 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 7-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 17, and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicants' remarks and amendments, filed on September 26 and December 12, 2007, have been carefully considered. Claims 15 and 16 have been canceled; new claims 17 and 18 have been added.

Claims 1-14, 17, and 18 are now pending in this application.

Election/Restrictions

1. Claims 7-14 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected process of improving the pour point of a paraffin charge, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 28, 2007.

Claims 1-6, 17, and 18 are now under consideration by the Examiner.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicants' Priority Document was filed on March 24, 2004.

Withdrawn Rejections

The 102(b) rejection of claims 1-5 as being anticipated by WO 02/48289 (with U. S. Patent Application Publication No. 2004/0065585 applied as its English language equivalent) stated in the previous Office Action has been withdrawn in view of Applicants' amendments and persuasive arguments traversing this rejection.

The provisional nonstatutory obviousness-type double patenting rejection of claims 1-6 as being unpatentable over copending Application Serial No. 10/807,504 (now U. S. Patent No. 7,282,465) stated in the previous Office Action has been withdrawn in view of Applicants' amendments and persuasive arguments traversing this rejection.

New Grounds of Rejection

The following New Grounds of Rejection are being made in view of the newly discovered reference to Benazzi et al. (U. S. Patent No. 7,250,106); the text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

3. Claims 1-6, 17, and 18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of Benazzi et al. (U.S. Patent No. 7,282,465, formerly Application Serial No. 10/807,504) in view of Benazzi et al. (U. S. Patent No. 7,250,106).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the respective sets of claims are directed to catalysts comprising at least one ZBM-30 molecular sieve zeolite synthesized with a structuring agent (e.g., triethylenetetramine), at least one hydro-dehydrogenating element, and at least one porous mineral matrix.

The claims in the instant application recite an additional component which is not recited in the claims of the '465 patent. However, Benazzi et al. '106 disclose a catalyst comprising ZBM-30 zeolite (synthesized preferably to an operating procedure that uses triethylenetetramine as a structuring agent; see col. 25, lines 30-35), at least one hydrodehydrogenating element, preferably selected from among the elements of Group VIB and Group VIII, at least one porous mineral matrix, and TON-structural-type zeolites such as theta-1, ZSM-22, ISI-1, NU-10, and KZ-2 (see col. 25, lines 4-12).

Both the instant claims and the claims in the '465 patent recite the term "comprising", which opens the claims to additional, unspecified, and non-deleterious components.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicants' invention was made to modify the catalyst of Benazzi et al. '465 by incorporating therein the TON-structural-type zeolites disclosed by Benazzi et al. '106, as it has been held that combining two or more materials disclosed by the prior art for the same purpose to form a third material that is to be used for the same purpose has been held to be a prima facie case of obviousness, see In re Kerkhoven, 205 U.S.P.Q. 1069.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Benazzi et al. (U. S. Patent No. 7,250,106).

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Benazzi et al. '106 disclose a catalyst comprising ZBM-30 zeolite synthesized preferably to an operating procedure that uses triethylenetetramine as a structuring agent (see col. 25, lines 30-35; considered to read upon **component (B) of claim 1**), at least one hydro-dehydrogenating element, preferably selected from among the elements of Group VIB and Group VIII (considered to read upon **component (C) of claim 1**, and also upon **claim 2**), at least one porous mineral matrix (considered to read upon **component (D) of claim 1**), and TON-structural-type zeolites such as theta-1, ZSM-22, ISI-1, NU-10, and KZ-2 (considered to read upon **component (A) of claim 1**, and also upon **claim 17**). See col. 25, lines 4-12 and 61-65 of Benazzi et al. '106.

Examples of the Group VIII element include platinum and palladium. See col. 25, line 66 to col. 26, line 5 of Benazzi et al. '106. (considered to read upon **claims 4, 5, and 18**).

Examples of the Group VI element include molybdenum and tungsten. See col. 27, lines 33-34 of Benazzi et al. '106 (considered to read upon **claim 3**).

The catalyst of Benazzi et al. '106 "optionally can be subjected to a sulfurization treatment". See col. 28, lines 11-17 of Benazzi et al. '106 (considered to read upon **claim 6**).

In view of these teachings, Benazzi et al. '106 anticipate Applicants' claims 1-6.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICIA L. HAILEY whose telephone number is (571)272-1369. The examiner can normally be reached on Mondays-Fridays, from 7:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PATRICIA L. HAILEY/
Examiner, Art Unit 1793
March 3, 2008